



UNITED STATES DEPARTMENT OF COMMERCE

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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/327,525 10/21/94 CHEE

M 1851034

REES, E

18N2/0919

EXAMINER

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SAN FRANCISCO CA 94105

ART UNIT

PAPER NUMBER

7

1807

DATE MAILED:

09/19/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on _____ This action is made final.
Restriction /

A shortened statutory period for response to this action is set to expire _____ month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 1-44 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims _____ are rejected.

5. Claims _____ are objected to.

6. Claims 1-44 are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

08327-525

Part III DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-20, drawn to a method of identifying an unknown base (CallSeq™), classified in Class 364, subclass 496.

Group II. Claims 21-26, drawn to a method of processing first and second nucleic acid sequences ("Pooling Processing"), classified in Class 435, subclass 6, for example.

Group III. Claims 27-44, drawn to a method of analyzing a plurality of sequences (ViewSeq™) , classified in Class 435, subclass 91.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the inventions have

separate utilities in that the method of Invention I may be used to determine the sequence of a nucleotide, the method of invention II may be used in hybridization assays that do not involve sequencing and the method of Invention III may be used for gene mapping assays and genotyping. The methods further involve distinct method steps and provide different outcomes.

See M.P.E.P. § 806.05(d).(i)

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. A telephone call was made to Michael Ritter on Sept 14, 1995 to request an oral election to the above restriction requirement, but did not result in an election being made.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

6. Papers related to this application may be submitted to Group 1800 by facsimile transmission via the P.T.O. Fax Center located in Crystal Mall 1. The CM1 Fax Center number is (703) 308-7939. Please note that the faxing of such papers must conform with the notice to Comply published in the Official Gazette, 1096 OG 30 (Nov 15, 1989).

An inquiry regarding this communication should be directed to examiner Dianne Rees, Ph.D., whose telephone number is (703) 308-6565. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1156.

Calls of a general nature may be directed to the Group receptionist who may be reached at (703) 308-0196.

Dianne Rees
Dianne Rees

Sept 15, 1995

S. Zitomer
STEPHANIE W. ZITOMER
PRIMARY EXAMINER
GROUP 1800